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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/758,317 | 01/12/2001 | Hisashi Semba | 04853.0055-00 | 9114 |
| 22852 | 7590 | 02/26/2003 | | |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20006 | | | EXAMINER | MARX, IRENE |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1651 | |

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|--------------------------------------|-------------------------------------|---|
| Advisory Action | Application No. 09/758,317 | Applicant(s) Semba et al. | |
| | Examiner Irene Marx | Art Unit 1651 |  |
| -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -- | | | |
| <p>THE REPLY FILED <u>Jan 22, 2003</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.</p> <p>Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.</p> | | | |
| THE PERIOD FOR REPLY [check only a) or b)] | | | |
| <p>a) <input checked="" type="checkbox"/> The period for reply expires <u>3</u> months from the mailing date of the final rejection.</p> <p>b) <input type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).</p> | | | |
| <p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p> | | | |
| <p>1. <input type="checkbox"/> A Notice of Appeal was filed on _____ . Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.</p> | | | |
| <p>2. <input checked="" type="checkbox"/> The proposed amendment(s) will not be entered because:</p> <ul style="list-style-type: none"> (a) <input checked="" type="checkbox"/> they raise new issues that would require further consideration and/or search (see NOTE below); (b) <input checked="" type="checkbox"/> they raise the issue of new matter (see NOTE below); (c) <input checked="" type="checkbox"/> they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or (d) <input checked="" type="checkbox"/> they present additional claims without canceling a corresponding number of finally rejected claims. | | | |
| <p>NOTE: <u>see attachment</u></p> <hr/> | | | |
| <p>3. <input type="checkbox"/> Applicant's reply has overcome the following rejection(s): _____ _____</p> | | | |
| <p>4. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</p> | | | |
| <p>5. <input checked="" type="checkbox"/> The a) <input type="checkbox"/> affidavit, b) <input type="checkbox"/> exhibit, or c) <input checked="" type="checkbox"/> request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>see attachment</u></p> <hr/> | | | |
| <p>6. <input type="checkbox"/> The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.</p> | | | |
| <p>7. <input checked="" type="checkbox"/> For purposes of Appeal, the proposed amendment(s) a)<input checked="" type="checkbox"/> will not be entered or b)<input type="checkbox"/> will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.</p> | | | |
| <p>The status of the claim(s) is (or will be) as follows:</p> | | | |
| <p>Claim(s) allowed: <u>none</u></p> | | | |
| <p>Claim(s) objected to: <u>none</u></p> | | | |
| <p>Claim(s) rejected: <u>11-13, 16-18, and 29-34</u></p> | | | |
| <p>Claim(s) withdrawn from consideration: <u>21, 22, 25-28, and 35-40</u></p> | | | |
| <p>8. <input type="checkbox"/> The proposed drawing correction filed on _____ is a)<input type="checkbox"/> approved or b)<input type="checkbox"/> disapproved by the Examiner.</p> | | | |
| <p>9. <input type="checkbox"/> Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.</p> | | | |
| <p>10. <input type="checkbox"/> Other:</p> | | | |
| IRENE MARX PRIMARY EXAMINER ART UNIT 1651 | | | |

Note:

The proposed amendment raises new issues that would require further consideration and/or search with respect to the phrase "adsorbed on a carrier" to replace "absorbed on a carrier", including new issues under 35 U.S.C § 112, of new matter. The specification as filed is directed to "absorption" (See, e.g., page 1) which suggests that the material is attached within the carrier. The proposed amendment is directed to "adsorption", i.e., attachment to the surface.

Claims 21-22, 25-28 and 35-40 remain withdrawn from consideration as directed to a non-elected invention as no claim is allowable.

The information disclosure statement filed 1/22/03 fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p) and/or lacks the petition fee set forth in 37 CFR 1.17(l). It has been placed in the application file, but the information referred to therein has only been considered to the extent that it is discussed in the response.

Response to Arguments

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

Applicant's arguments are directed to claims that are not entered.

With respect to the obviousness rejection, applicants allege that the differences in enzymes would have had an impact and go on to say that there would not be an expectation of success because of the structural differences in the enzymes of interest, as shown by the references newly presented. However, applicants fail to recognize that all the claims as written require is an (S)-hydroxynitrile lyase "derived" from certain sources attached to a porous substrate. Applicants tout differences in structure and predictability of retention of activity. Yet the claims are devoid of any requirement of retention or enhancement of catalytic activity as argued (Response, page 8). Therefore, extensive arguments and various references directed to enzyme homology are not clearly relevant to the invention as claimed directed to an immobilized enzyme. It is unclear how "structure" is relevant in this context.

The rejections of record are deemed proper and are maintained for the reasons of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (703) 308-2922. The examiner can normally be reached on Monday through Friday from 6:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The appropriate fax phone number for the organization where this application or proceeding is assigned is before final (703) 872-9306 and after final, (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service whose telephone number is (703) 308-0198 or the receptionist whose telephone number is (703) 308-1235.

Irene Marx

Irene Marx
Primary Examiner
Art Unit 1651